

SERIAL NO. 75/746284 Proxim, Inc.	APPLICANT
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MARK HARMONY

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ACTION NO. 03

MAILING DATE 06/26/02

REF. NO.

FORM PTO-1525 (5-90)

U.S. DEPT. OF COMM. & TM OFFICE

021775-086

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Proxim, Inc.	:	BEFORE THE
Trademark:	HARMONY	:	TRADEMARK TRIAL
Serial No:	75/746284	:	AND
Attorney:	Robert E. Krebs	:	APPEAL BOARD
Address:	Burns, Doane, Swecker & Mathis Post Office Box 1404 Alexandria, VA 22313-1404	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's final refusal to register the mark HARMONY for "wireless networking system of products, namely, modems, PC adaptors, gateways, access bridges and related operating and driver software for sharing computing resources and access to a global computer information network and access to a local computer network." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) because there is a likelihood of confusion between the mark for which registration is sought and a prior registration.

FACTS

On July 8, 1999, the applicant applied to register the mark HARMONY for “cordless networking products for use in homes, home offices and small offices to share computing resources and to provide access to the Internet and corporate intranets.”

On December 10, 1999, the examining attorney notified the applicant of a potential refusal of registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) and the applicant was required to amend the identification of goods. On June 7, 2000, the applicant submitted a response to the First Office Action, amending the identification of goods and arguing against the potential refusal under Section 2(d) of the Trademark Act.

On August 7, 2000, the examining attorney notified the applicant that the potential refusal under Section 2(d) of the Trademark Act as to one of the cited applications had been withdrawn and that the other cited application, Serial No. 75-729053 had proceeded to registration, Registration No. 2,368,383, and issued a refusal under Section 2(d) of the Trademark Act. On February 7, 2001, the applicant submitted a response to the Office Action arguing against the refusal under Section 2(d) of the Trademark Act and amending the identification of goods. On June 4, 2001, the examining attorney issued a final refusal under Section 2(d) of the Trademark Act and as to the identification of goods.

On December 4, 2001, the applicant filed a notice of appeal and request for reconsideration. On February 8, 2002, the amended identification of goods was accepted, however, the request for reconsideration concerning the refusal under Section 2(d) of the Trademark Act was denied. On April 15, 2002, the applicant filed its appeal brief. On May 2, 2002, the applicant's appeal brief was forwarded to the examining attorney.

ISSUE

The applicant's mark is confusingly similar to the mark in U.S. Registration No. 2,368,383 such that when used with the identified goods it is likely to cause confusion, to cause mistake and to deceive and should therefore be refused registration under Section 2(d) of the Trademark Act.

ARGUMENTS

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 2,368,383 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.*

The law applicable to this refusal is well settled. There are two steps in an analysis to determine whether there is a likelihood of confusion. First, the marks themselves must be compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the goods must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The applicant's mark is HARMONY for "wireless networking system of products, namely, modems, PC adaptors, gateways, access bridges and related operating and driver software for sharing computing resources and access to a global computer information network and access to a local computer network." The registrant's mark is HARMONI for "computer software, namely, programmable software which monitors and diagnoses network and network traffic problems."

I. Similarity of the Marks

Marks must be compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977). TMEP §§1207.01(b) *et seq.* Here, the applicant's mark and the registered mark are confusingly similar in appearance, sound and overall commercial impression.

Similarity in appearance is one consideration in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance notwithstanding the addition, deletion or substitution of letters or words. *See, e.g., Weiss Associates Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for computer software); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (McKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with McKENZIE for canned fruits and vegetables); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing

textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

Here, the applicant's mark is the word HARMONY and the registered mark is the term HARMONI. The only difference in the two marks is the substitution of the letter Y in the applicant's mark for the letter I in the registered mark. This substitution does not obviate the similarity in appearance, sound and overall commercial impression of the two marks. In fact, the applicant concedes that the applicant's and registrant's marks are "phonetically similar." (Applicant Brief at 2). Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv). Furthermore, the Federal Circuit has held that the use of a phonetic equivalent with a slight misspelling does not result in a term with a markedly different appearance from a registered mark. *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (ROPELOK for safety fall protection equipment held to be confusingly similar to the mark ROPELOCK for releasable locking buckles for ropes). Here, because the applicant's and registrant's marks are phonetic equivalents, the slight difference in the spelling of the marks does not obviate a finding that the marks are confusingly similar in sound, appearance and overall commercial impression.

II. Comparison of Goods

The second step in determining whether there is a likelihood of confusion is to compare the goods to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 38 (TTAB 1978). The applicant is seeking registration for "wireless networking system of products, namely, modems, PC adaptors, gateways, access bridges and related operating and driver

software for sharing computing resources and access to a global computer information network and access to a local computer network.” The registrant has registered its mark for “computer software, namely, programmable software which monitors and diagnoses network and network traffic problems.”

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Here, the goods of the applicant and registrant are related and could be used in conjunction with one another in that they both have computer software or hardware used for networking functions. The applicant provides computer hardware for accessing networks, while the registrant's software monitors traffic on those networks.

The excerpts of articles printed from Nexis and the third party registrations attached to the final office action dated June 4, 2001, should be noted. This evidence indicates that the goods for which the applicant is seeking registration, namely, PC adaptors, gateways, access bridges, and modems, comprise “computer” hardware and therefore are related to and likely to be used in conjunction with the registrant's computer software. Of particular note are the following:

VYYO, Registration No. 2,430,117, for “computer hardware for use as wireless telecommunications devices in local area computer networks, wide area computer networks, and global computer networks, namely hubs, modems, bridges, transverters, converters and cable interface units; computer network management software and telecommunications network management software for wireless telecommunications networks; and manuals sold as a package therewith”

indicating that wireless hardware such as modems and bridges are commonly referred to as "computer" hardware and are marketed in conjunction with software used for managing networks.

SPHERE and design, Registration No. 2,445,398, for goods and services including "gateways, namely, computer hardware, operating software and peripherals" indicating that "gateways" are comprised of "computer" hardware and software.

The Nomadix design mark, Registration No. 2,393,678 for "computer hardware and software, namely routers, switches, network gateways and network adapters, and user manuals sold as a unit" indicating that gateways and adaptors used in networks are commonly called "computer" hardware.

AVICI, Registration No. 2,373,386 for "computer hardware, namely routers and bridges; computer programs for use in the control and monitoring of routers and bridges" indicating that bridges are commonly called "computer" hardware and marketed in conjunction with computer software for monitoring bridges and routers.

The October 17, 2000, article from *Inc.* indicating that modems are commonly considered "computer" hardware states: "... then a semidormant reseller of used computer hardware, such as IBM computers and Codex modems."

The October 4, 1999, article from *Design News* indicating that telecommunications equipment such as modems and routers are commonly categorized as "computer" hardware states: "The company is a manufacturer of high-performance embedded microprocessors for processing information in computer hardware devices such as routers, printers, data storage systems and cable modems."

The July 19, 1999, article from *Electronic Buyers News* indicating that communication and networking devices such as LAN cards, modems and hubs are commonly called "computer" hardware states: "Taiwan is the world's largest supplier of several kinds of computer hardware including LAN cards, hubs, keyboards, modems, power suppliers, motherboards, monitors, scanners and computer cases."

The November 1, 1998, article from *WINDOWS Magazine* indicating that adapters for personal computers, or PC adapters, are commonly called "computer" hardware states: "Computer hardware is advancing at such a dizzying pace that even the most hard-core early adapters can have trouble keeping up."

The applicant relies on *Astra Pharmaceutical Products v. Beckman Instruments*, 220 USPQ 786 (1st Cir. 1983), for the proposition that "use in the same field is not

sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion.” However, this case is inapposite because it did not involve computer hardware and software. In fact, that case did not involve the relatedness of goods at all. The court even stated, “as counsel for Astra conceded in oral argument, this is not a confusion of goods case. The products involved in this case have few, if any, similarities.” *Astra Pharmaceutical Products*, 220 USPQ at 790. The case at hand is readily distinguishable in that the Trademark Trial and Appeal Board has held that computer hardware products are so related to computer software products that their marketing under the same or similar marks may be likely to cause confusion as to source under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). *In re Graphics Technology Corp.*, 222 USPQ 179 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cii Honeywell Bull*, 223 USPQ 363 (TTAB 1984). Thus, in this instance, unlike in the *Astra* case, the computer software and computer hardware goods are related and an issue of confusion of goods does exist. In fact, in this case, the issue is not just that the applicant has computer hardware and the registrant has computer software, it is that the computer software and hardware are used for related purposes, specifically for networking purposes.

The applicant’s argument that the goods are distinguishable because of their expense and the sophistication of the purchasers is unpersuasive. The fact that customers may exercise deliberation in choosing their networking products “does not necessarily preclude their mistaking one trademark for another” or that they otherwise are entirely immune from confusion as to source or sponsorship when the marks are similar and the merchandise is in the same general field. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). Moreover, the Trademark Trial and Appeal Board has found that the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re*

Decombe, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Furthermore, it is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). If the cited registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the registration encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Here, the registrant did not limit its identification of goods to specify the type of network for which its software is used or to whom its software is marketed. Thus, it must be presumed that it may be used for diagnosing and monitoring traffic on all networks, including the type of wireless network for which the applicant has related goods.

Thus, the similarity in the appearance, sound and overall commercial impression of the applicant's mark and the registrant's mark and the relatedness of the applicant's and registrant's goods are sufficient to sustain a finding that the marks are confusingly similar under Section 2(d) of the Trademark Act. Therefore it is respectfully requested that the refusal to register the intended mark on the Principal Register under Trademark Act Section 2(d), 15 U.S.C Section 1052(d), be affirmed.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), be affirmed.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Stacy B. Wahlberg". The signature is fluid and cursive, with the first name "Stacy" and last name "Wahlberg" clearly distinguishable.

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